

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kyler, et al. US Appl. No.: 10/553,825
Filed: 10/20/05 Docket No: 20030081
PCT No.: PCT/US04/12425 Int. Filing Date: 4/21/04
For: Process for Preparing High Purity TNT

CERTIFICATE OF MAILING 37 CFR 1.8: I certify that this correspondence is being deposited on the below date with the U.S. Postal Service with sufficient postage as FIRST CLASS MAIL addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, PO Box 1450, Alexandria, VA 22313-1450.

Date:

4.16.07

Maureen Miles



Dear Commissioner:

RESPONSE TO DECISION

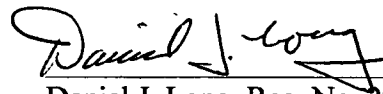
This is a response to the DECISION to Applicant's petition under 37 CFR 1.47 (a) filed 1/8/07, for the above-referenced matter. An executed Declaration for Patent Application and Power of Attorney is enclosed and is timely filed prior to the two month deadline.

Transmitted herewith is the following:

- ☒ 2 pages signed declaration and power of attorney,
- ☒ 3 page copy of DECISION,
- ☒ We understand that no additional petition fee is required, but the Office is hereby authorized to charge any deficiency or credit any overpayment in the fees relating to the attached submittal to Deposit Account 190130.

Please communicate, through our customer number 22500, with the undersigned attorney if there are any questions.

Respectfully submitted,



Daniel J. Long, Reg. No. 29,404

BAE Systems
PO Box 868
Nashua, NH 03061-0868
Tel. No. (603) 885-2643
Fax. No. (603) 885-2167

CASE NO. **20030081****DECLARATION FOR PATENT APPLICATION (37 CFR 1.63) AND POWER OF ATTORNEY**

DECLARATION: As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name. I believe that I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Process For Preparing High Purity TNT

a specification of which [] is attached hereto OR [X] was filed on 21 APR 2004 as United States Application Number or PCT International Application Number US2004/012425. I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above. I acknowledge the duty to disclose information which is material to patentability as defined in Title 37 Code of Federal Regulations §1.56. I hereby claim foreign priority benefits under 35 U.S.C. §119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT International application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)Priority Claimed

(Number)	(Country)	(Date filed)	Yes	No
----------	-----------	--------------	-----	----

I hereby claim the benefit under 35 U.S.C. §119(e) of United States application(s) listed below.

Provisional Application Number(s):

60/464,286

Filing Date(s):

4/21/03

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s) or 365(c) of any PCT International application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

Application Ser. No.Filing DateStatus-Patented, Pending or Abandoned

POWER OF ATTORNEY: I hereby appoint as my attorney, with full powers of substitution and revocation, to prosecute this application and transact all business in the U.S. Patent and Trademark Office connected therewith:

USPTO CUSTOMER NO. 22500**Daniel J. Long, Reg. No. 29,404**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

All Inventor's are listed below:

Solo or first Inventor's Name (first, middle if any, last) Keith S. Kyler


Additional Inventor's Name (first, middle if any, last) Andrew R. Wilson

Additional Inventor's Name (first, middle if any, last) Curtis Teague

Additional Inventor's Name (first, middle if any, last) _____

ALL INVENTORS

I have read the first page of this declaration for patent application, and I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Solo or first Inventor's Name (first, middle if any, last) Keith S. Kyler
Residence Address: 1401 University Blvd, Apt. D-3, Kingsport, TN 37660
Country US Citizenship US
Post Office Address: Same as residence
Signature:  Date: 4-7-07

Additional Inventor's Name (first, middle if any, last) Andrew R. Wilson
Residence Address: 1237 Sussex Drive, Kingsport, TN 37660
Country US Citizenship US
Post Office Address: Same as residence
Signature: _____ Date: _____

Additional Inventor's Name (first, middle if any, last) Curtis Teague
Residence Address: 1045 Allandale Circle, Kingsport, TN 37660
Country US Citizenship US
Post Office Address: Same as residence
Signature: _____ Date: _____

Additional Inventor's Name (first, middle if any, last) _____
Residence Address: _____
Country _____ Citizenship _____
Post Office Address: _____
Signature: _____ Date: _____



16 FEB 2007

22500
BAE SYSTEMS INFORMATION AND ELECTRONIC SYSTEMS INTEGRATION INC.
65 Spit Brook Road
P.O. Box 868 NHQ1-719
Nashua, NH 03061-0868

In re Application of
KYLER *et al*
U.S. Application No.: 10/553,825
PCT No.: PCT/US04/12425
Int. Filing Date: 21 April 2004
Priority Date: 21 April 2003
Attorney Docket No.: 20030081
For: PROCESS FOR PREPARING HIGH
PURITY TNT

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 08 January 2007.

BACKGROUND

On 31 July 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 08 January 2007, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration signed by two of the three named inventors; a statement by Daniel J. Long; a three-month extension and fee; the petition fee of \$200.00; a copy of a letter dated 21 September 2006; a copy of an email dated 21 September 2006 and authorization to charge any additional fee to Deposit Account No. 19-0130.

DISCUSSION

Applicants claim that they have been unable to locate Keith Kyler and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 31 July 2006.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors. Applicants completed items (1) and (3) with this petition.

RECEIVED

FEB 20 2007

PATENT DEPARTMENT

Concerning item (1), the petition fee is now \$200.00. Petitioners submitted a \$130.00 petition fee. The \$70.00 difference has been charged to Deposit Account No. 19-0130 as authorized.

With regards to item (3), the last known address of co-inventor Keith Kyler is listed as:

1401 University Blvd., Apt D-3
Kingsport, TN 37660

However, regarding item (2) of 37 CFR 1.47(a), section 409.03(d) of the MPEP discusses situations where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants submitted a statement of facts by Mr. Long, an attorney representing the assignee. Mr. Long states that a letter sent to the last known address of the nonsigning inventor was returned as being undeliverable. Moreover, a co-inventor was contacted by email, but he did not know the whereabouts of Mr. Kyler. A copy of the email and a copy of the cover letter sent to the nonsigning inventor was included as evidence in the petition. Petitioners did not state that they made any other attempts to locate the nonsigning inventor and no other evidence was provided.

This evidence is insufficient to show that a "diligent effort" was made to locate the nonsigning inventor. Petitioners did not even attempt to locate Mr. Kyler using the internet or telephone. In addition, Mr. Kyler would likely belong to professional organizations. Moreover, a check with Human Resources and other co-workers should be done to see if anyone has any information on the whereabouts of Mr. Kyler.

Documentary evidence of the attempts made to locate the nonsigning inventor should be included with any renewed petition. For these reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by one of the two co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, address and citizenship of all three inventors are recorded on the declaration as required. However, this declaration fails to comply with 37 CFR 1.497(a) and (b).

Petitioners submitted one first page and two second pages of the declaration. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Applicants must submit the complete declaration signed by each co-inventor.

For this reason, item (4) of 37 CFR 1.47(a) is also not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

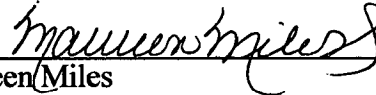
In re Application of: Kyler, et al. US Appl. No.: 10/553,825
Filed: 10/20/05 Docket No: 20030081
PCT No.: PCT/US04/12425 Int. Filing Date: 4/21/04
For: Process for Preparing High Purity TNT

CERTIFICATE OF MAILING 37 CFR 1.8: I certify that this correspondence is being deposited on the below date with the U.S. Postal Service with sufficient postage as FIRST CLASS MAIL addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, PO Box 1450, Alexandria, VA 22313-1450.

Date:

4.16.07

Maureen Miles



Dear Commissioner:

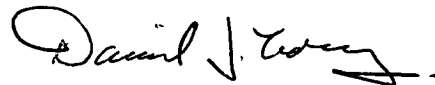
PRELIMINARY AMENDMENT

Please amend the applicant Keith Kyler's address to the following:

Indiana University of Pennsylvania
Weyandt Hall, 229A
Indiana, PA 15705

PAYMENT: All necessary fees relating to the attached submittal, if any, are intended to be included. However, the Office is hereby authorized to charge any deficiency or credit any overpayment in the fees to deposit account 190130.

Respectfully submitted,



Daniel J. Long, Reg. No. 29,404

Customer Number 22500
BAE Systems
PO Box 868
Nashua, NH 03061-0868
Tel. No. (603) 885-2643
Fax. No. (603) 885-2167